

REMARKS

Claims 1 and 5-15 were withdrawn from consideration by the Examiner.

Claims 2-4 are pending and under consideration.

**PAGES 2-3: REJECTION OF INDEPENDENT CLAIM 2 UNDER 35 U.S.C. §102(e) AS
ANTICIPATED BY REVASHETTI ET AL. (U.S.P. 6, 370,578)**

The Examiner rejects claim 2 under 35 U.S.C. §102(e) as anticipated by Revashetti.

(Action at pages 2-3).

Independent claim 2 recites an information presentation device in which a user terminal on a network that retrieves products or services that match search parameters designated by the user, said information presentation device including "accepting means for accepting a selection of a product or service that is included in said products or services that were retrieved; and parameter storage means for storing the search parameters for the selected product or service as a candidate for purchase, together with user identification information that identifies said user terminal."

As provided in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must teach every aspect of a claimed invention. Revashetti does not support an anticipatory-type rejection by not describing features recited by in claim 2, for example, Revashetti does not teach "parameter storage means for storing the search parameters."

According to an aspect of the present invention needs of a user are extracted over a network without burdening the user. Thus, sales of products and services provided over a network by using the extracted needs are accordingly increased. A search parameter used by a user in searching products and services on the network is stored and is provided to a product/service provider. Since the product/service providers can know a user's needs from the provided search parameter, they can effectively advertise their current products and services, and further consider a user's needs in consideration of new product development.

Revashetti merely teaches a system for actively marketing products to a user of a client computer in which a plurality of vendor computer systems are connected over the Internet to a user computer via a service provider computer system. Revashetti teaches that an active marketing host program downloads a product information database to the user computer. A scan method scans a configuration of the user computer, and presents marketing opportunities to the user of the user computer.

The Examiner mistakenly contends that the recited term "search parameters" is taught by a Revashetti's teaching of a "key" in the Windows Registry. (Action at page 2). However, as

recited in claim 2 a "search parameter" that a user specified when searching product information is stored assuming the user's preference. For example, a "search parameter" is specified by a character string or numbers that the user has selected it is also possible that a plurality of search parameters are specified for one product.

On the other hand, a Registry key in Windows, as taught by Revashetti, is not determined by a user, but solely by an Operating System. Such a key is singly assigned to an application installed in a client computer, and a plurality of keys cannot be assigned to one application.

Assuming *arguendo* that the Examiner's contention is correct then it would necessarily follow that Revashetti (see, for example, col. 11) would teach an active marketing host program selecting an application from a current configuration of a client computer, e.g., a "selection of a product being searched with a key" (accepting means).

However, Revashetti does not teach a parameter "storage means, "or *arguendo* a "storage" of a key for the selected product or service together with user identification information. Rather, Revashetti teaches (see, for example, col. 3, lines 51-55) that:

(i)n a preferred embodiment, a product information database, a marketing rule knowledge base and an opportunity detection object are downloaded to a client computer from a service provider computer system.

That is, product information is merely presented to the user.

Further, claim 2 recites "identifying said first user terminals that have selected a first product as a candidate for purchase."

The Examiner mistakenly contends:

together with user identification information that identifies said user terminal (analysis is particular to a given computer col. 6 lines 61-63 and hence inherently must include identification of the client computer 208).

Applicants submit that Revashetti merely teaches (col. 6, lines 60-62) to "analyze the current configuration of the client computer."

Applicants submit that the Examiner has not provided any support for the inherency that analysis of a current configuration teaches "identification" of a client computer, let alone identifying "first user terminals that have selected a first product as a candidate for purchase." For example, a configuration can be identified as having a 20GB hard drive, along with a multitude of other computers so identified, but such identification does not identify a first user terminals that have selected a first product as a candidate for purchase.

Conclusion

Since Revashetti does not teach features recited in claim 2, the rejection should be withdrawn and claim 2 allowed.

PAGES 35: REJECTION OF DEPENDENT CLAIMS 3-4 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER REVASHETTI IN VIEW OF WELSH ET AL. (U.S.P. 6,757,691)

On page 3 of the Office Action the Examiner indicates:

(c)laim 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Revashetti et al. in view of Welsh et al. Revashetti et al. disclose the invention substantially as claimed as set forth above with respect to claim 2, but not with respect to the limitations of claims 3 and 4.

Applicants assume that the Examiner indication of claims 2-6 is a typographical error and that the Examiner rejects claims 3-4 under 35 U.S.C. 103(a) as being unpatentable over Revashetti in view of Welsh et al.

Dependent claims 3-4 recite an information presentation device including "user reference request accepting means for accepting user reference requests from first group of computer terminals on said network; and parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals, and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal."

As provided in MPEP §2143 entitled *Basic Requirements of a Prima Facie Case of Obviousness*:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants submit there is no reasonable chance of success to modify a system taught by and that the Examiner rejects claims 3-4 under 35 U.S.C. 103(a) as being unpatentable over Revashetti that teaches marketing based on a current computer configuration with a system taught by Welsh of marketing of based on a predicted behavior.

Conclusion

Since there is no reasonable chance of success to combine the art in a manner as the Examiner suggests, *prima facie* obviousness is not established, the rejection should be withdrawn and claims 3-4 allowed.

CONCLUSION

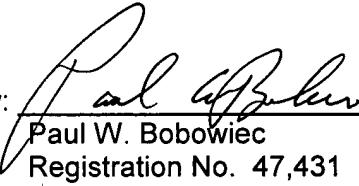
There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: 
Paul W. Bobowiec
Registration No. 47,431

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1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501